

### **REMARKS**

These remarks are submitted in response to the Office Action dated August 5, 2010 (hereinafter the "Office Action"). At the time of the Office Action, claims 1-20 and 22-24 were pending. The rejection under 35 U.S.C. § 101 of Claims 14-20 has been withdrawn. Claims 1-20 and 22 were rejected under 35 U.S.C. §103.

Claims 1, 2, 4, 5, 7-11, 13-15, 17, 18, 20 and 24 have been amended, and new claims 25-27 have been added. New claims 25-27 correspond to the previously added claim 24 and are supported by the specification and drawings (see, for example, paragraph [0113] of the published application). Therefore, no new matter has been added.

The Examiner indicated that claims 23 and 24 contain allowable subject matter and would be allowable if rewritten in independent form including all of the recitations of the base claim and any intervening claims.

The Applicant would like to thank Examiner Chang for conducting a telephone conference on August 25, 2010, to discuss the various rejections and claim amendments. Applicant's position as articulated during the interview is set forth below.

#### **I. Claim Rejections Under 35 USC §103**

The Examiner rejected claims 1-19 and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0128356 to Bernstein et al. (hereinafter "Bernstein"), in view of U.S. Patent Application Publication No. 2003/0229670 to Beyda (hereinafter "Beyda"), and U.S. Patent Application Publication No. 2005/0030937 to Wick et al. (hereinafter "Wick").

The Examiner rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Bernstein in view of Beyda and Wick, and further in view of U.S. Patent Application Publication No. 2002/0065894 to Dalal et al. (hereinafter "Dalal").

For the following reasons, these rejections are respectfully traversed.

## **II. Response**

Claim 1 has been amended to include the subject matter of objected-to claim 23; namely, that multiple instant messaging addresses of the contact are stored in order of priority in the address book database. Thus, claim 1 should be in form for immediate allowance.

Claims 9, 10, and 14 have also been amended to recite that multiple instant messaging addresses of the contact are stored in order of priority in the address book database. Thus, claims 9, 10, and 14 likewise clearly patentably distinguish over any reasonable interpretation of the cited references. For example, claim 9 recites "means for determining, with an instant messaging client and utilizing a processor that is executing the instant messaging client, an Internet presence of a contact identified in an email message in response to displaying the email message to a user, wherein the means for determining compares an email address of the contact identified to an address book database and retrieves an instant messaging address of the contact identified from the address book database, and then uses the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user" and "wherein multiple instant messaging addresses of the contact are stored in order of priority in the address book database." Claim 10 recites "presence logic of an instant messaging client and utilizing the processor that is executing the instant messaging client, configured to determine an Internet presence of a contact identified in an email message in response to displaying the email message to a user, wherein the presence logic compares an email address of the contact identified to an address book database and retrieves an instant messaging address of the contact identified from the address book database, and then uses the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user" and "wherein multiple instant messaging addresses of the contact are stored in order of priority in the address book database." The Examiner acknowledges that Bernstein, Beyda, and Wick fail to disclose that multiple instant messaging addresses of the contact are stored in order of priority in the address book database.

Note that independent claims 9 and 10 have also been amended to make minor editorial changes thereto.

Claim 14 recites, *inter alia*, a non-transitory, computer-readable storage medium being embedded with computer instructions for causing a computing device to: instruct a programmable device to determine, at an instant messaging client, an Internet presence of a contact from an email message in response to displaying the email message to a user, wherein the determining comprises comparing an email address of the contact to an address book database and retrieving an instant messaging address of the contact from the address book database, and then using the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user, and wherein multiple instant messaging addresses of the contact are stored in order of priority in the address book database. Again, as acknowledged by the Examiner, Bernstein, Beyda, and Wick fail to disclose that multiple instant messaging addresses of the contact are stored in order of priority in the address book database. Thus, claim 14 is likewise patentable over the cited references.

The dependent claims are patentable in view of the arguments set forth above with respect to the corresponding independent claims, as well as based on the recitations set forth therein.

Moreover, new dependent claims 25-27 have been added and recite that the order of priority is based on the user arranging each instant messaging address in order of the user's preference. This feature is also missing in the cited references.

**CONCLUSION**

The application is now in full condition for allowance. The Examiner is invited to call the undersigned representative if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion. Please charge any deficiencies or credit any overpayment to Deposit Account No. 50-0951.

Respectfully submitted,

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